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EXAMINER

BROWN, T

ART UNIT PAPER NUMBER

2601

4

DATE MAILED: 09/02/92

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

**Part II SUMMARY OF ACTION**

- ☒ Claims 1-16 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

- ☐ Claims \_\_\_\_\_ have been cancelled.

- ☐ Claims \_\_\_\_\_ are allowed.

- ☒ Claims 1-16 are rejected.

- ☐ Claims \_\_\_\_\_ are objected to.

- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

- ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

- ☐ Formal drawings are required in response to this Office action.

- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

- ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

- ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).

- ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

- ☐ Other

EXAMINER'S ACTION

1. In addition to the informalities noted by the Official Draftsman, the drawings are objectionable for obvious misspellings in labels of several blocks, to wit: FIG. 3, block 48; FIG. 4, block 60; and FIG. 7, block 34 (in the latter, "COMPLETES" obviously should be instead ---COMPLETE---).

APPLICANTS ARE REQUIRED TO SUBMIT IN RESPONSE TO THIS ACTION A PROPOSED DRAWING CORRECTION WHICH ADDRESSES ALL OF THE INFORMALITIES NOTED ABOVE. However, correction of the noted defects can be deferred until the application is allowed by the examiner.

2. The disclosure is objected to because of the following informalities:

The text (for example, at page 6, line 29 to page 7, line 4) and claims 2 and 3 contain an objectionable misdescription, "ring signal" (emphasis added), whereas what obviously is involved, in view of the disclosure as a whole, is what is known in the art as a "ringback" signal, which is one of various known call progress signals. As is old and well known in the art, a ring signal is the alerting signal received at a called station to advise a called party that a call has been received. Note the patent of Sleeve and Japanese '661, which properly identify the ringback signal. While admittedly not all applicants have been consistent in the proper use of the art-recognized term "ringback", the examiner submits that at least where claimed terms are involved, applicants should try to be precise with respect to art terms.

At page 9, lines 7-8, the statement, "In the preferred embodiment, the microprocessor 100 is a [sic: ---an---] IBM compatible personal computer." (emphasis added) obviously is

inaccurate and therefore speculative. As is well known in the art, a personal computer may comprise a microprocessor, but it is not accurate to say that a microprocessor may be a personal computer.

At page 19, line 6, "correct" obviously should be instead ---connect---.

Appropriate corrections are required.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112: The specification shall contain a written description of the invention, and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to provide an adequate written description and enabling disclosure of the invention as represented in claim 16.

As noted in Section 5 below, claim 16 is considered functional, since it defines no structural distinction from its parent claim. But even if the claim had defined a means for performing the indicated function, that function is not found to <sup>be</sup> supported by the text and drawings. In the description and drawings, the examiner finds no indication of why and when the prerecorded announcement would be "changed, upgraded or deleted from a remote location", much less a description of how that would be done. Thus, the disclosure is considered clearly deficient with respect to claim 16. TWS

4. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

5. Claims 6, 7, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, "the selection of the type of announcement" (emphasis added) lacks clear antecedence. Furthermore, it is unclear how the calling party "can participate in [any] selection of [a] type of announcement", since the claim recites no structural distinction from the parent claim, much less provides any indication of how it would in practice relate to the structures thereof.

Claim 7 is vague as to any connections and the intended purpose of the recited "video terminal".

In claim 15, "said generated announcement" (emphasis added) lacks antecedent basis. Furthermore, it is unclear how, when and under what circumstances the caller "can interact" with an announcement, the claim obviously lacking structure and specific indications with respect thereto.

Claim 16 is unclear with respect to what constitutes a "remote location" (emphasis added), much less by what means the prerecorded announcement "can be changed, upgraded or deleted" therefrom.

6. In the art rejections below, the inclusion of claims rejected above as indefinite is based on the examiner's best guess as to what applicants intended those claims to define.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 10, 12-14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Baral et al.

See column 4, line 46 to column 5, line 13 of the patent. Note that whether the caller is presented with either a ring(back) or a busy signal, the system can provide prerecorded announcements, either between or superimposed on the call progress signals. Note further that the patented system is applicable in a local, multi-exchange or toll system (see column 5, lines 11-13), as required in applicants' claims 12-14. The broad terms of these claims are found to be clearly readable on the reference.

9. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10. Claim 6 is rejected under 35 U.S.C. 103 as being unpatentable over Baral et al. as applied to claim 1 above, in view of either Akiyama or Sheinbein (cited by applicants).

Both Akiyama (see column 7, lines 10-14 and 33-36) and Sheinbein (see column 4, lines 1-25, and columns 5 and 6) teach arrangements for callers provided with stored prerecorded announcements to "participate in the selection" thereof. Inasmuch as all three of the references involve automatically providing callers with prerecorded announcements based on the party called, the motivation to apply the teachings of Akiyama or Sheinbein in the Baral et al. system is inherent.

11. Claims 7-9 and 11 are rejected under 35 U.S.C. 103 as being unpatentable over Baral et al. as applied to claim 1 above, in view of Sleeve (cited by applicants).

The "video terminal" of claim 7 presumably was intended to refer to a computer monitor, and it further is presumed that applicants intended to define a capability for display of a message on the monitor, if connected to the line at the caller's terminal. Such arrangements were in fact well known, furthermore in systems providing messages to callers in association with call progress signals: see Sleeve, column 9, lines 32-36. The Segre-Amar patent

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cited by applicants also has such teaching: see therein column 2, lines 18-23; column 8, lines 9-15; and column 9, lines 52-55. These well-known teachings clearly would have been recognized as applicable to Baral et al. system, in view of the clearly similar overall purposes.

As for the "sequence of announcements" features of claim 8, that is considered clearly inherent in the similar Sleevi system, wherein note column 7, lines 5-8.

The busy/idle status checking (claim 9) and immediate connection to calling party upon answer of the called party (claim 10) also are well taught by Sleevi: see therein column 5, lines 22-34. Sleevi also specifically teaches the very well-known feature of digital storage of announcements (claim 11): see therein column 6, lines 10-18.

12. No attempt to compare applicants' claim 16 to the prior art was made above, because of the lack of support and indefiniteness thereof, which however should not be taken as an indication of potential for allowability. As applicants are no doubt aware, capability for "remote" modification of prerecorded announcements was well known in the art.

11. Applicants' information disclosure statements of February 3, 1992 (Paper No. 2) and August 14, 1992 (Paper No. 3) are noted. Although applicants did not supply a copy of the Blom patent, and did not individually discuss the references submitted with Paper No. 3, the examiner nevertheless has considered all of the cited references.

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The Sleeve, Akiyama, Segre-Amar and Sheinbein references are considered the most pertinent of those cited by applicants, and they have been discussed above. The patent of Lesavoy et al. is relevant in that it shows how old is the general concept of providing prerecorded messages to callers in association with call progress signals. JA '661 also is considered of general relevance, although less so than those cited by the examiner above. The other references cited by applicants do not appear to be of any particular relevance to what applicants are claiming.

12. Any inquiry concerning this communication by the examiner should be directed to Examiner Thomas W. Brown, whose telephone number is (703)305-4733. Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist whose telephone number is (703)3058-4750.



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8/28/92